

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on May 2, 2007, the Examiner rejected claims 12-15, 26-27, 35 and 37-41 under 35 U.S.C. § 103(a) as unpatentable over Skonecki (U.S. Patent No. 5,305,550) in view of Roulleau (U.S. Patent No. 5,142,976). Applicants respectfully traverse this rejection and submit that the claims are not rendered obvious by the cited art.

Applicable Standards:

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine

the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

Section 103 specifically requires assessment of the invention “as a whole.” The Federal Circuit explained that inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). The Federal Circuit further explained that

[w]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. [*Ruiz* at 1275.] This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Id.*

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Princeton Biochemicals Inc. v. Beckman Coulter Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Additionally, under Section 103, objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. MPEP § 2141. To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must

flow from the functions and advantages disclosed or inherent in the description in the specification. MPEP § 716.03(b). Also, the commercial success must be due to claimed features, and not due to unclaimed features. MPEP § 716.03(a).

Application of Applicable Standards to the Current Rejections

Applicant recognizes that the current Examiner is not the original examiner assigned to the case. Applicant therefore believes that the Examiner may not be aware of and may not have considered the objective indicia of nonobviousness that was previously submitted in this case. Applicant therefore respectfully resubmits the previously-submitted evidence for the Examiner's consideration in conjunction with the arguments made below.

In the Office Action, the Examiner provided a detailed Response to Arguments, which Applicant appreciates. Applicant respectfully continues to disagree with the Examiner's conclusion that it would have been obvious to one of skill in the art to combine Skonecki and Roulleau in the manner suggested by the Examiner to arrive at the claimed invention. Applicant believes that the previously-submitted evidence shows that persons skilled in the art did not find the claimed invention obvious even many years after the effective dates of the cited references.

In response to the Examiner's statement that a flower has an elasticity that allows for a substantial compressive force to be applied and still recover to its original shape, the Examiner has not recognized that one of skill in the art would recognize that the flower's very elasticity would prevent the use of the system of Roulleau with flowers, as the elastic movement of the flowers would cause smudging of the pad-printed image. Applicant's prior arguments and suggested experiment regarding the force of Roulleau that show that the Roulleau invention would break a previously-cracked egg primarily show that the force of the Roulleau pad-printing

machine and mechanism is sufficient to cause elastic bending or deformation of the flower, resulting in such a smudged and unacceptable image. Therefore, Applicant maintains that one of skill in the art would not expect success in combining the references in the manner suggested by the Examiner.

Applicant's position is amply documented and supported by the previously-submitted evidence and indicia of non-obviousness, which is resubmitted herewith for the consideration of the Examiner. Attached are declarations from various persons regarding the claimed invention, as follows:

Declaration dated September 22, 2003 by Blaine Harris, then-president of the assignee of the present application;

Declaration dated May 27, 2004 by Chris Osburn, owner of a licensee of the claimed invention;

Declaration dated June 1, 2004 by Candice Harris, director of a licensee of the claimed invention;

Declaration dated May 25, 2004 by Gary E. Doran, president of a licensee of the claimed invention; and

Declaration dated May 21, 2004 by George Barquin, vice-president of a licensee of the claimed invention.

The information contained in the attached declarations provides objective indicia of the fact that the claimed invention was generally and widely considered non-obvious in 2003-2004, approximately ten years after the issuance of the patents relied on by the Examiner in the current

rejections. In light of this objective evidence of non-obviousness, as detailed below, Applicant respectfully requests that the Examiner reconsider the rejections.

Applicant has had considerable commercial success and success in finding partners for licensing agreements. The considerable success in finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise, licensing agreements would not be necessary. The following are examples of this success and are supported by the attached declaration.

Licensing

In 2003, Applicant had entered into licensing agreements with Taylor Corporation, the largest wedding card printing company in the nation with over 87% of the nation's wedding card printing business. Applicant had also licensed its product to GiftTree (gifttree.com), a large corporate and public web site. FTD.com had also licensed, featured, and sold Applicant's product. USA Bouquet, based in Miami, Florida had also licensed Applicant's product. Chicago-based Kennecott Brothers had also licensed Applicant's product. Kennecott Brothers, servicing 1800 retail outlets, had licensed Applicant's equipment, both the printers and the engravers. In addition, Applicant had licensed over 80 individual retail shops around the nation with the capacity to print flowers on their own premises. Other Licensees included Sam's Club, Publix (850 retail outlets), and others. (See Declaration of Blaine Harris, as supported by the other signed declarations of four licensees.)

Applicant's considerable success in finding partners for licensing agreements shows incredible commercial success. This success in licensing shows is clearly related to the disclosed

and claimed invention, as is clear from the attached declarations of the licensees. (See Declarations of George Barquin, Gary Doran, Candice Harris, and Chris Osburn.)

Commercial Success

As set forth in the declaration of Blaine Harris, Applicant's licensing agreement with FTD.com generated sales of approximately seventy dozen flowers a day in 2003. Other participants in Applicant's sales network in 2003 included Taylor Corporation; Giftree.com; USA Bouquet; Kennecott Brother's 1800 retail establishments and its large Super Floral groups including Jewel Osco/Albertsons; 80 individual retail shops; Sam's Club; Publix's 850 retail outlets; Golden Rose in Canada; the Zuriel group in Holland and Europe; wholesalers in the United States, including Delaware Valley in the Northeast, Denver Floral Wholesale in the Northwest and through Colorado, and Mellano in Southern California and Nevada; and other individual planners of large corporate events and weddings. (See Declaration of Blaine Harris.)

Applicant's considerable success in establishing its extensive sales and marketing network by finding partners for licensing agreements shows the commercial success of embodiments of the present invention, and show that such success flows from the functions and advantages disclosed in the description in the specification and claimed in the appended claims. (See Declarations of George Barquin, Gary Doran, Candice Harris, and Chris Osburn.)

Long-Felt Need

The present invention also solves the long-felt need for a repeatable, rapid method for laying a design onto a flower that preserves the integrity of the flower. Evidence of this long-felt need is found in Skonecki, which documents this need dating back to 1993. See Skonecki,

Column 2, lines 16-18. Applicant's success in licensing its product further shows this long-felt need was not solved by Skonecki and shows that Applicant's product solves this long-felt need. (See Declaration of Blaine Harris.) The licensees of Applicant's claimed invention have specifically attested and further demonstrated that a long-felt need has existed that is addressed by Applicant's claimed invention. (See Declarations of George Barquin, Gary Doran, Candice Harris, and Chris Osburn.)


Therefore, in light of the comments above and the attached evidence, Applicant respectfully submits that the claimed invention is not made obvious by the cited combination of references. Applicant therefore respectfully requests that the Examiner reconsider the rejections in light of the above and attached information, and promptly allow the application.

CONCLUSION

Applicant submits that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, or if the Examiner would like to suggest amended claim language, the Examiner is invited to call the undersigned.

DATED this 31 day of August, 2007.

Respectfully submitted,


Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893